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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/417,174	04/05/95	KAWAKAMI	028-111-01

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18M2/0105

EXAMINER
HUEF.S

ART UNIT	PAPER NUMBER
1806	15

01/05/98

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/417,174

Applicant(s)  
Kawakami et al

Examiner  
Sheela J. Huff

Group Art Unit  
1806



☒ Responsive to communication(s) filed on Nov 10, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) 1-14 and 32-38 is/are withdrawn from consideration.

☒ Claim(s) 15-28 is/are allowed.

☒ Claim(s) 29-31 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed on 11/10/97 has been considered. Applicant's arguments are deemed to be persuasive.

Claims 15-31 are currently under consideration. Claims 1-14 and 32-38 are withdrawn from consideration as being drawn to a non-elected invention.

2. All of the rejections have been withdrawn in view of applicant's amendments.

### *New Grounds of Rejection*

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 29 and 31 are rejected under 35 U.S.C. 102(a) as being anticipated by Maresh et al DNA and Cell Biology vol. 13 p. 87 (2/94). These rejected claims depend from claims 15 or 22. Claims 15 or 22 are not subject to this restriction because they do not read on the full length gp100--these claims are limited to small fragments.

This reference discloses the deduced amino acid sequence of ME-20(Fig. 2) and the expression of ME-20(p. 91-92). The amino acid sequence of ME-20 corresponds to gp100. This reference also discloses the making of antibodies to ME20

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and purification of ME20 antigen (see pages 88-89). Because the terminology "immunogenic" and "pharmaceutical" are intended use, they carry no patentable weight in composition claims. Additionally, because of the use of open language ("comprising") in the claims, the antigen can be present with anything (ie the antigen can be in a cell).

***Claim Rejections - 35 USC § 112***

5. Claims 29-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 30, the terminology "or an immunogenic peptide fragment thereof" renders the claim vague and indefinite. What is the length of the fragment. Is this supposed to read on dipeptides? Did applicant mean to have claim 30 depend from claims 15 and 22?

b. In claims 29 and 30 there should be a --)-- after "SEQ ID NO:27".

***Allowable Subject Matter***

6. Claims 15-28 are allowed.

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**Conclusion**

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is (703) 305-7866. The examiner can normally be reached on Monday-Thursday from 6:30am to 3:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached on (703)308-2731. The FAX phone number for this Group is (703)308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [lila.feisee@uspto.gov].

All Internet e-mail communications will be made of record in the application file. **PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122.** This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Sheela J. Huff  
December 31, 1997

  
Sheela J. Huff  
Primary Examiner  
Group 1800